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Shapiro Cohen LLP
P.O. Box 13002
Kanata, ON K2K 0E2
CANADA

EXAMINER

QAYYUM, ZESHAN

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RONALD DICKE and GORDON FREEDMAN

Appeal 2015-001297¹
Application 13/160,974²
Technology Center 3600

Before JOSEPH A. FISCHETTI, NINA L. MEDLOCK, and
TARA L. HUTCHINGS, *Administrative Patent Judges*.

MEDLOCK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1–6.³ We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Our decision references Appellants' Appeal Brief ("Br.," filed June 17, 2014) and the Examiner's Answer ("Ans.," mailed September 3, 2014) and Final Office Action ("Final Act.," mailed December 19, 2013).

² Appellants identify the inventors, Ronald Dicke and Gordon Freedman, as the real parties in interest. Br. 3.

³ Claims 17–19 have been canceled. *See* Amendment After Final filed March 19, 2014; Advisory Action mailed March 31, 2014.

CLAIMED INVENTION

Appellants' claimed invention "relates generally to digital books or e-books, and more particularly to a method and system for distributing digital books" (Spec. ¶ 1).

Claim 1, reproduced below, is the sole independent claim, and representative of the subject matter on appeal:

1. A method comprising:
 - in dependence upon purchasing a physical copy of a first book, receiving a code comprising an identifier of the first book;
 - providing the code to an electronic device via an input portion thereof;
 - establishing a communication session between the electronic device and a digital bookstore via a communication network;
 - transmitting the code from the electronic device to the digital bookstore via the communication network during the communication session;
 - in response to providing the code, receiving from the digital bookstore via the communication network a digital book copy of the first book; and,
 - storing the digital book copy of the first book on a storage portion of the electronic device.

REJECTIONS

Claims 1, 3, 4, and 6 are rejected under 35 U.S.C. § 103(a) as unpatentable over Van Zoest (US 6,609,105 B2, iss. Aug. 19, 2003) and Dionne (US 2007/0043669 A1, pub. Feb. 22, 2007).

Claim 2 is rejected under 35 U.S.C. § 103(a) as unpatentable over Van Zoest, Dionne, and Rempe (US 2008/0046374 A1, pub. Feb. 21, 2008).

Claim 5 is rejected under 35 U.S.C. § 103(a) as unpatentable over Van Zoest, Dionne, and Storey (US 2007/0250711 A1, pub. Oct. 25, 2007).

ANALYSIS

Independent Claim 1

We are not persuaded by Appellants' arguments that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103(a) as unpatentable over the combination of Van Zoest and Dionne (Br. 5–9). Instead, we agree with, and adopt the Examiner's findings and rationale as set forth at pages 9–13 of the Answer. We add the following discussion for emphasis only.

By way of background, Van Zoest is directed to a system and method for providing user access to electronic works over a network, and discloses that in one embodiment, the user verifies that he/she is authorized to access an electronic copy of the work by demonstrating that he/she possesses a physical copy of the work (Van Zoest, Abstract; *see also id.* at col. 2, ll. 36–46; col. 5, ll. 13–35). Van Zoest discloses that a user may demonstrate ownership of a physical work in a variety of ways; for example, the user may enter a confirmation number received with the purchase of the physical work (*id.* at col. 11, ll. 50–60).

Dionne is directed to a method for unlocking digital content embodied in digital readable form on a digital media carrier, e.g., a CD, DVD, flash memory card, etc. (Dionne, Abstract; *see also id.* at ¶ 24), and discloses that in one embodiment, the locked digital content is a book or other printed publication stored on a CD (*id.* at ¶ 25). The CD also includes digital media unlocking software designed to unlock the digital content upon receipt of a user input; the unlocking software requires that the user have physical possession of the book (*id.* at ¶¶ 24, 26–29).

In rejecting claim 1 under 35 U.S.C. § 103(a), the Examiner relies on Van Zoest as discloses substantially all of the limitations of claim 1 except

the Examiner notes that Van Zoest does not explicitly disclose that the work is a physical book (Final Act. 5). The Examiner cites Dionne to cure the deficiency of Van Zoest (*id.*). And the Examiner concludes that claim 1 would have been obvious to a person of ordinary skill in the art at the time of Appellants' invention because the combination of Van Zoest and Dionne only involves the simple substitution of one known element, i.e., the book of Dionne, for another, i.e., the Van Zoest work, producing a predictable result (*id.* at 5–6; see also Ans. 9–10).

Appellants argue that the Examiner has combined the Van Zoest and Dionne references using impermissible hindsight to arrive at Appellants' invention and that the Examiner has improperly relied on the disclosure of the present application to find the motivation to combine the cited references (Br. 5–7). Yet, as described above, the Examiner provided articulated reasoning with some rational underpinning to support the obviousness conclusion at pages 5–6 of the Final Office Action. The Examiner's rejection also appears clearly based on the disclosures of the Van Zoest and Dionne references, and not on the disclosure of the present application. Absent specific, technical arguments as to why the motivation is insufficient or why the proposed combination is more than the simple substitution of one known element for another, we find Appellants' hindsight argument unpersuasive.

In view of the foregoing, we sustain the Examiner's rejection of independent claim 1 under 35 U.S.C. § 103(a).

Dependent Claim 2

Claim 2 depends from claim 1, and recites that “the code is imprinted on a sales receipt for the physical copy of the first book.”

In rejecting claim 2 under § 103(a), the Examiner notes that the combination of Van Zoest and Dionne does not explicitly disclose that “the code is imprinted on a sales receipt for the physical copy of the first book,” as recited in claim 2. The Examiner cites Rempe to cure this deficiency (Final Act. 9 (citing Rempe ¶ 15)). However, the Examiner notes that the phrase “wherein the code is imprinted on a sales receipt for the physical copy of the first book,” as recited in claim 2, is non-functional descriptive material, and may not be relied on to distinguish over the prior art for purposes of patentability (*id.*). We agree.

The Federal Circuit has long held that where a limitation claims printed matter that is not functionally or structurally related to its physical substrate, the printed matter may not be relied on to distinguish over the prior art for purposes of patentability. *See, e.g., In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). The rationale underlying the “printed matter” cases also has been extended to the analysis of the patentability of method claims. *King Pharmaceuticals Inc. v. Eon Labs, Inc.*, 616 F.3d 1267, 1278-79 (Fed. Cir. 2010) (applying the “printed matter” reasoning to method claims containing an “informing” step that could be either printed or verbal instructions).

Here, the relevant inquiry is whether the recitation in claim 2 that the code is “imprinted on a sales receipt for the physical copy of the first book,”

rather than being provided in some other way, has a “new and unobvious functional relationship” with the method. *Id.* at 1279. We agree with the Examiner that it does not.

There is no objective evidence of record that there is a functional distinction in providing a code to a purchaser of a physical copy of a book by imprinting the code on the sale receipt for the book as opposed to providing the code in another way. Regardless of the particular vehicle used for communicating the code, the underlying method is the same. The nature of the mechanism used to communicate the code does not depend on the method, and the method does not depend on the nature of the mechanism used to communicate the code. As such, it constitutes non-functional descriptive material that may not be relied on for patentability. *See In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004).

In view of the foregoing, we sustain the Examiner’s rejection of claim 2 under 35 U.S.C. § 103(a).

Dependent Claims 3–6

For much the same reasons outlined above with respect to claim 2, we also are not persuaded that the Examiner erred in rejecting claims 3–6 under 35 U.S.C. § 103(a). Similar to claim 2, each of claims 3–6 recites features, i.e., the nature and content of the claimed code and/or the input portion of the claimed electronic device, that do not functionally affect how the claimed method is performed.⁴ As such, the claims recite non-functional

⁴ Specifically, claims 3–6 recite that the input portion of the electronic device comprises a keyboard (claim 3) or a scanner (claim 4) and the claimed code comprise a string to alphanumeric characters (claim 3), a machine-readable symbol (claim 4), an email confirmation including the code (claims 5) or a single use code (claim 6).

descriptive material that may not be relied on to distinguish over the prior art for purposes of patentability.

Therefore, we sustain the Examiner's rejection of claims 3–6 under 35 U.S.C. § 103(a).

DECISION

The Examiner's rejections of claims 1–6 under 35 U.S.C. § 103(a) are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED